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Paper No. 21

David G. Duckworth  
DRUMMOND & DUCKWORTH  
5000 Birch St., Suite 440, East Tower  
Newport Beach, CA 92660

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**APR 24 2002**

**OFFICE OF PETITIONS**

In re Reissue Application of	:	
Edward A. MARUE et al.	:	
Reissue Application No. 09/596,850	:	DECISION
Filed: June 19, 2000	:	ON PETITION
Original Patent No. 5,615,855	:	37 CFR 1.183
Issue Date: April 1, 1997	:	
For: TELESCOPING MAST WITH	:	
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This is a decision on the petition under 37 CFR 1.47(a), filed August 13, 2001, under 37 CFR 1.47(a), and the petition under 37 CFR 1.183, filed February 6, 2002, which are collectively being treated as a petition under 37 CFR 1.183 requesting waiver of 37 CFR §§ 1.67 and 1.172 which would require that the supplemental reissue declaration required by the office action of October 22, 2001 have been executed by all the named inventors.<sup>1</sup>

The petition is **dismissed**.

Applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.183 and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the nonsigning inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

The original patent named Marue and Pereira as inventors. Thus, as filed, the named inventors were and remain Edward A. Marue and Kenneth J. Pereira.

As noted in In re Hayes, 53 USPQ2d 1222 (Comm'r Pats. 1999) the remedy for acceptance of the supplemental reissue declaration lies via a waiver under 37 CFR 1.183

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<sup>1</sup> Rule 47 only applies where, in the first instance, the signature of an originally named, or to be added, inventor can not be obtained. As Marue and Pereira executed the original declaration and thus made the application, 37 CFR 1.47 no longer applies to the issue. See 37 CFR 1.47; MPEP 201.03. Rather, the remedy lies under 37 CFR 1.183 when a required supplemental declaration is not executed in whole or in part by a previously signing inventor(s). See MPEP 603.

of 37 CFR 1.172, and does not lie under 37 CFR 1.47<sup>2</sup>. In this instance however, the showing of unavailability is not accepted with respect to Kenneth Pereira. If petitioner were able to make a showing that if, after diligent effort, Mr. Pereira could not be contacted or refuses to sign the supplemental oath or declaration, the above-noted waiver with respect to Pereira's signature would also apply to any supplemental declarations that may be forthcoming in this application.

Petitioner asserts that Mr. Pereira has refused to execute a supplemental reissue declaration. Petitioner cites numerous attempts to contact the non-signing inventor via mail and telephone, and a conversation with Mr. Pereira's girlfriend, Linda, during which it was stated that, according to Linda, Mr. Pereira would not be willing to sign any documents supporting the instant application.

A petition under 37 CFR 1.183 requesting waiver of the reexecution of the oath or declaration is evaluated as to whether the nonsigning inventor was actually given the opportunity to reexecute the oath or declaration, or whether the nonsigning inventor could not be reached. In this case, the petition lacks a showing to the satisfaction of the Commissioner that the nonsigning inventor cannot be reached or has refused to reexecute the declaration. Petitioner alleges that numerous attempts to contact the nonsigning inventor have been made, however there is no showing of record that the non-signing inventor has been contacted or that he refuses to reexecute the oath or declaration.

Where inability to find or locate a named inventor is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied upon to establish that a *diligent effort* was made to locate the inventor. The statement(s) of fact must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. More specifically, petitioner should demonstrate attempts to locate and/or contact nonsigning inventor Pereira. If inventor Pereira is located, then a copy of the reissue oath or declaration should be mailed to Mr. Pereira's address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. If the papers are returned and all other attempts to locate or reach the inventor, e.g., through personnel records, co-workers, E-mail, the Internet or the telephone, etc., continue to fail, then applicant will have established that the inventor cannot be reached or has refused to join in the application. The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. If the inventor is

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<sup>2</sup> As such, the request for refund of the fee for the petition filed under 37 CFR 1.47 is granted. A check for \$130 will be mailed to petitioner under separate cover.

located and the inventor orally refuses to sign the supplemental oath or declaration, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. If, on the other hand, petitioner receives an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

**In order to expedite consideration, petitioner may wish to submit the renewed petition under 37 CFR 1.183 by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.**

Further correspondence with respect to this matter should be addressed as follows:

By mail:           U.S. Patent and Trademark Office  
                      P.O. Box 2327  
                      Mailstop DAC  
                      Arlington, VA 22202

OR

Commissioner for Patents  
Box DAC  
Washington, D.C. 20231

By FAX:           (703) 308-6916  
                      Attn: Office of Petitions

By hand:           Crystal Plaza Four, Suite 3C23  
                      2201 South Clark Place  
                      Arlington, VA 22202

Telephone inquiries related to this decision should be directed B. Dayoan at (703) 308-3865 or, in her absence, to the undersigned at (703) 305-1820.



Brian Hearn  
Senior Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy